

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No. 3588
Stefan HOFMAIR et al.)
Serial No. 10/581,482) Examiner: Peter Y. CHOI
Filed: March 21, 2007) Group Art Unit: 1786
International Filing Date: November 24, 2004)
For: TEXTILE LABEL AND METHOD FOR)
THE PRODUCTION THEREOF) Date: May 17, 2011

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby requests formal review of the February 17, 2011, final office action because the Examiner fails to properly consider all the claimed limitations to establish a *prima facie* case with respect to obviousness under 35 U.S.C. § 103(a).

This paper is being filed concurrently with a Notice of Appeal and the requisite fee, as required in the guidelines for the New Pre-Appeal Brief Conference Pilot Program published in the July 12, 2005, Official Gazette Notice.

Claims 1, 3-7 and 10-16 are pending, of which claims 2 and 8-9 have been cancelled previously, and claims 17-24 have been withdrawn by the Examiner as being drawn to a non-elected invention. Claims 1, 3-5, 7, 10, 15 and 16 stand finally rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Baldwin (US 5,982,284 – hereinafter Baldwin) in view of Taylor (US 4,626,311 – hereinafter Taylor). Claims 6, and 11-14 stand finally rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Baldwin and Taylor and in further view of Tirkkonen (WO 01/75843). These rejections are in error and should be withdrawn because the cited documents, whether considered individually or in combination, fail to teach, suggest or otherwise render obvious each and every limitation recited in independent claim 1 and its respective dependent claims 3-7 and 10-16.

Initially, Appellant respectfully notes that, in applying Baldwin, the Examiner repeated fails to be diligent in pointing out which specific features in Baldwin correspond specifically to Appellant's claimed features. Although the Examiner cites numerous drawing figures and long textual descriptions in Baldwin to support the rejections, the Examiner has not provided specific concrete support or showing of direct correlation for each of the features that Examiner deems as relevant to Appellant's claimed invention. Therefore, Appellant respectfully requests the Examiner to further clarify the rejections with specificity as to how and which features of Baldwin are relevant to each and every claimed feature in the presently claimed invention for the record.

Notwithstanding the above, Appellant respectfully submits that Baldwin fails to teach each and every claimed feature, and Taylor, as well as Tirkkonen, fails to cure the deficiencies of Baldwin, for the reasons set forth below.

Claim 1 is directed to a textile label having a textile base layer (e.g., 2), a transponder arrangement including a chip (e.g., 5) and an antenna (e.g., 6) bonded to the textile base layer (2) by a first adhesive layer (e.g., 3), a second adhesive layer (e.g., 4), and an additional textile layer including an upper label (e.g., 7) bonded to the remainder of the label by the second adhesive layer (4), wherein the chip (5) is covered and sealed by the second adhesive layer (4), and wherein the antenna is sealed against environmental influences by the first and second adhesive layers (3, 4). According to the embodiment recited in claim 1 of the present invention, the chip (5) is in direct contact the second adhesive layer (4), since the transponder arrangement according to the present invention has no housing or the like surrounding the chip and antenna.

In contrast, according to Baldwin, the transponder is laminated between two insulation sheets of paper 12 and 36, as described in column 3, lines 16 and 17. Further, as shown in Fig. 4 of Baldwin, there is an adhesive-free region formed of an adhesive-deadening material 50 sandwiched between adhesive layer 18 and the chip 52 so as to create the essential air gap or air pocket 35 while antenna 53 has an adhesive-free region 54. Hence, Appellant's claimed textile label having chip (5) covered by the second adhesive layer (4) and antenna and lacked an adhesive-free region or an air gap is clearly different from Baldwin.

Moreover, according to Balwin, an air gap 35 is provided around the perimeter of the RFID chip which eliminates the wrinkle that would otherwise be created by the edge of the RFID chip, as described in column 2, lines 44 to 46. This air gap is mandatory so as to render the RFID chip as less recognizable as possible. Therefore, the RFID chip in accordance with Baldwin's description with the air gap 35 further includes a feature that leads away from Applicant's claimed features wherein the chip being covered by the second adhesive layer (4) and is sealed by the second adhesive layer (4). That is, Appellant's claimed invention does not require an air gap and adhesive-free region as Baldwin does.

Further, while Baldwin utilizes sheets 12 and 16 made of paper, Appellant's invention of a textile label includes a textile base layer (2) and additional textile layer including an upper label (7). In applying Baldwin, Examiner contends that paper sheets (e.g., 12 and 16) are within the scope of Appellant's textile base layer and the additional textile layer. In response, Appellant respectfully submits that paper sheets of Baldwin may not have tear-resistant property, and to remedy this, Baldwin teaches the use of tear resistant layer 32 between paper sheet 36 and the antenna 53. Appellant notes that the paper sheet 12 of Baldwin is not directly covered by any tear-resistant layer, however. Accordingly, in view of the clear usage of paper material in Baldwin, Applicant respectfully submits that Baldwin's sheets of paper does not suggest a textile and cannot be construed as textile in this case.

With respect to Taylor, the reference does not cure the above-mentioned deficiencies of Baldwin, and there is no suggestion or motivation to combine the features of Taylor with the laminated tag/label of Baldwin. Specifically, Taylor teaches an inner member of device 22 being an elongate strip 24 of magnetically detectable material. The magnetically detectable strip 24 is encapsulated in a fluid-tight manner (col. 3, lines 47-50) by a cover member 25 made of a thermoplastic material. The antitheft device 22 is attachable to a cloth product. Hence, similar to Baldwin, Taylor fails to teach, disclose or suggest at least a textile base layer and an additional textile layer. Moreover, Taylor does not appear to teach, disclose or suggest a chip and antenna transponder arrangement.

Applicant respectfully submits that the elongated magnetically detectable material encapsulated in a thermoplastic cover member 25 to form a fluid-tight device teaches away from a textile label of Applicant's claimed invention because of the lack of textile base layer and additional textile layer, and because the inflexible and bulky nature of the antitheft device

22, and that one skilled in the art would not consider combining the antitheft device 22 of Taylor with the flexible, thin laminated tag or label of Baldwin as contended by the Examiner.

With respect to Tirkkonen, as previously argued, this patent does not deal with the sealing of a chip within a label, and even less with the sealing with two adhesive layers. There is simply no suggestion to a person of ordinary skill in the art for sealing a transponder arrangement by means of two adhesive layers, wherein the chip being covered by the second adhesive layer and is sealed by the second adhesive layer against environmental influences including one of water, suds, chemical cleaning agents and heat by the second adhesive layer, and the antenna being sealed against the environmental influences by the first and the second adhesive layer, as recited in amended claim 1.

Moreover, as previously submitted, Tirkkonen describes a smart label which may be attached to a textile material. The label comprises a chip 2 fixed to the label 1 with an adhesive layer 3 and a back film 4 (see Figure 2 and page 5, lines 20-26). As described on page 4, line 37 to page 5, line 5, an electroconductive ink is printed on the back film or a metal film is etched or punched to manufacture the antenna of the smart label. Therefore, the use of a foil is mandatory in combination with a label according to Tirkkonen. A substitution of such a foil with a textile layer is not suggested.

Further, manufacture the antenna of the chip as disclosed by Tirkkonen would not be realizable if a textile label were to be disposed as the back film, since electroconductive ink could not be printed on a textile label so as to form an antenna for a RFID chip. Thus, Tirkkonen would appear to teach away from use of a textile upper label as recited in claim 1.

Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render claims 1, 3-7 and 10-16 unpatentable, however, the Office must do more than merely “consider” each and every feature for these claims. Instead, the asserted combination of the Baldwin, Taylor and Tirkkonen must also teach or suggest *each and every claim feature*. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the

differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added).

Finally, Appellants respectfully direct attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. *See In re Wada and Murphy, citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

For all the foregoing reasons, and those presented in the arguments submitted in Appellant's response of December 3, 2010, which are incorporated herein by reference, withdrawal of all the pending rejections of the claims and allowance of this application is earnestly solicited.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,

/Donald R. Studebaker/
Donald R. Studebaker
Registration No. 32,815

Studebaker & Brackett PC
One Fountain Square
11911 Freedom Drive
Suite 750
Reston, Virginia 20190
(703) 390-9051
Fax: (703) 390-1277
don.studebaker@sbpatentlaw.com